

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

AUG. 24, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rocin Laboratories, Inc.

v.

Surgijet, Inc., by change of name from Sentinel Medical,
Inc.¹

Opposition No. 106,653
to application Serial No. 75/000,862
filed on October 2, 1995

Robert L. Cucin, M.D., Esq. for Rocin Laboratories, Inc.

Harris Zimmerman, Esq. for Surgijet, Inc., by change of name
from Sentinel Medical, Inc.

Before Simms, Hairston and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

An intent-to-use application has been filed by
Surgijet, Inc. to register the mark LIPOTOME on the
Principal Register for "medical instruments, namely, tissue
emulsifiers and aspirators."

¹ The records of the Assignment Branch of this Office indicate
that the original applicant changed its name to Surgijet, Inc.
(recorded at reel 1648, frame 0030).

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Rocin Laboratories, Inc. filed a timely notice of opposition on June 18, 1997. The most relevant allegations are reproduced below:

Rocin Laboratories had and has already obtained a Common Law Trademark by its widespread use of the trademark in national and international commerce over the past three years.

Petitioner has employed the trademark and published its use widely on the internet in the world-wide web (address omitted) for several years. Petitioner's intent and usage of the trademark and such national and international publication leave no doubt as to Petitioner's having established a Common Law trademark as it has been widely employed in seeking prototypers and investors already.

Petitioner has demonstrated a bona fide intention to use the mark in commerce and in connection with the above-identified goods when such goods are ready for sale.

While the notice of opposition is not particularly artfully drafted, it is apparent that opposer is claiming priority and likelihood of confusion as the basis of the opposition.² See Fed. R. Civ. P. 8; and Scotch Whisky Assoc. v. United States Distilled Products Co., 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

Applicant, in its answer, admitted that it filed an application on October 2, 1995; and that prior thereto,

² Opposer's allegations regarding applicant's "bad faith" do not constitute a ground for opposition. Moreover, these allegations were not pleaded as fraud pursuant to Fed. R. Civ. P. 9. In any event, opposer offered no proof thereon. The Board does not take judicial notice of registrations or applications at this Office. See TBMP §712.01.

opposer had filed two applications, both of which were abandoned for failure to file a statement of use (one in 1992 and one in 1995). Applicant otherwise denied the salient allegations of the notice of opposition.³

The record consists of the pleadings⁴; the file of the involved application; and opposer's testimony of Dr. Robert L. Cucin, opposer's founder and president, and director of the laboratory. Applicant did not take any testimony or offer any other evidence. Only opposer filed a brief.⁵ An oral hearing was not requested by either party.

The opposer bears the burden of proof in this case, and must establish its claims by a preponderance of the evidence. See *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989).

³ Applicant also set forth affirmative defenses. Inasmuch as applicant did nothing other than pleading these defenses, they must fail.

⁴ Statements made in pleadings cannot be considered as evidence in behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony. See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); and *Times Mirror Magazines, Inc. v. Sutcliff*, 205 USPQ 656 (TTAB 1979). See also, TBMP §706.01.

⁵ Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. See *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018 (TTAB 1983); and *Abbott Laboratories v. TAC Industries, Inc.*, 217 USPQ 819 (TTAB 1981). See also, TBMP §706.02.

Dr. Robert L. Cucin testified⁶ that in early 1990 opposer commenced the development of "a surgical device, a method of liposuction" (dep., p. 7) which opposer planned to market under the trademark LIPOTOME; that this development began through mass mailings to different manufacturers of surgical devices; that opposer has received about 30 to 40 inquiries about the device, and ultimately opposer received a letter of intent from Gensyn General with regard to entering into a "licensure agreement" with opposer; and that Dr. Cucin sent "my patent and my prototype" to Gensyn General (dep., p. 12).

He further testified that opposer's first prototype of a liposuction device was developed from 1992 to 1994; that although no such devices have been sold, opposer took the prototype device across state borders, and it was "used on patients" (dep., p. 8); and that the device is on its fourth generation prototype, which is not substantially different from the first, but it is updated based on every new patent that issues (three so far). In early 1991 opposer set up a website which includes information on "the Lipotome suction curettage" (dep., p. 11); that the purpose of the website "is to state the progress of its development, to seek finance, to seek venture capital, to seek prototypers interested in further development of this device," "and also

⁶ Applicant did not attend the deposition of opposer's witness.

to keep in contact with my physician friends who know I have been involved in this project and are interested already in purchasing this for their practices as soon as it becomes available" (dep., p. 11); that opposer's usage of the mark has been continuous since 1990; and that those exposed to opposer's trademark are "the major manufacturers of plastic surgical devices,..., and anybody who has been on the Internet who has done a search on the term 'lipotome' or 'liposuction.'" (dep., p. 14). When asked who would be deceived by someone else using the mark LIPOTOME in connection with another surgical device, Dr. Cucin answered "the patients would be deceived, the manufacturers would be deceived, and the public would be deceived." (dep., p. 16).

"Use in commerce" is defined in Section 45, in part, as follows: "The term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark."

In this case, the record reveals that opposer's mark has never been used in commerce on goods within the meaning of Section 45 of the Trademark Act because there is simply no evidence that opposer ever produced a surgical instrument, namely an aspiration device, to which the involved mark was affixed and offered to relevant consumers. The fact that opposer has been attempting to obtain financing for the development and manufacture of this

product, does not amount to use in commerce under Section 45. Even the fact that a prototype of the device was actually made, taken across state lines, and used on patients does not in any way establish that the trademark was affixed thereto, or that relevant purchasers were aware of this use. Opposer offered no documentary evidence of any type which would establish use of its mark on goods -- no invoices, no labels, no promotional brochures. Although Dr. Cucin testified that a prototype device exists, there is no evidence that a product with the mark affixed thereto exists at all. See *Gay Toys, Inc. v. McDonald's Corporation*, 585 F.2d 1057, 199 USPQ 722 (CCPA 1978); *Beech Aircraft Corporation v. Lightning Aircraft Company Inc.*, 1 USPQ2d 1290, 1294 (TTAB 1986); and *Miles Laboratories, Inc. v. International Diagnostic Technology, Inc.*, 220 USPQ 438, 441 (TTAB 1983).

While it is well settled that an opposer may base its opposition on prior use of a term in a manner analogous to trademark use; it is also true that such an opposition can succeed only where the "analogous use" is of such a nature and extent as to create public identification of the term with opposer's product. See *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996). As the Court stated in the *T.A.B. Systems* case, *supra* at 1882, "An unbroken line of precedents of both this

court and the Board make clear that activities claimed to constitute analogous use must have substantial impact on the purchasing public."

In the case now before us there is no evidence of any use or "use analogous to trademark use" of the mark on the goods. The mere existence of a website in opposer's name does not establish use of this particular mark for these goods, nor that the website reaches the intended relevant purchasers of the involved goods. The record before this Board falls far short of showing that there is public identification of the term LIPOTOME with opposer's product, which itself is still in the prototype stage.

Opposer cannot obtain priority on the basis of abandoned applications; and its testimony is insufficient to preclude registration to applicant.⁷

Opposer raised other issues in its brief. Suffice it to say that fraud was neither properly pleaded nor proven, and the other reasons argued by opposer are insufficient to even state a claim.

Decision: The opposition is dismissed.

R. L. Simms

⁷ In view of the parties' marks and the parties' goods, if opposer had used the mark LIPOTOME on surgical instruments, namely, aspiration devices, confusion may have been likely.

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P. T. Hairston

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board